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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/458,132	02/16/00	SPRAGUE	W SPRAGUE-REI-

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EXAMINER

GEHMAN, B

ART UNIT	PAPER NUMBER
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3728

DATE MAILED:

09/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/458132

Applicant(s)

Sprague et al

Examiner

Gelman

Group Art Unit

3728

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply³

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 2/16/00
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 111; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-15 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1-4 is/are allowed.
- ☒ Claim(s) 5-15 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 3728

1. The drawing of Figure 6, filed on February 16, 2000 has been disapproved because it introduces new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure filed August 9, 1996 does not support the showing of a width of 4.812". The proposed insertion was not allowed in the prior application, but applicants amended the formal drawings in the earlier case to incorporate this new matter, without consideration by the examiner at the time.

2. The abstract of the disclosure is objected to because the term VERI MAG PACK is capitalized. Only trademarks should be capitalized. Unless applicants submit proof that the capitalized term is a trademark, the term should not be capitalized. Correction is required. See MPEP § 608.01(b).

3. The indicated use of a trademark, VERI MAG PACK has been noted in this application. If it in fact a trademark, it is proper that it be capitalized wherever it appears and be accompanied by the generic terminology. However, it is not clear that the term is a registered trademark.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Art Unit: 3728

4. The reissue filing of December 9, 1999 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the paragraphs added directed to U.S. Patent Nos. 5,918,909, 5,609,253, 5,427,832, 3,773,2515,294,041 and 5,376,048 on pages 2-4, the reference to "with exemplary dimensions of approximately" at line 11 of page 7, the reference to "approximately" at line 12 of page 8, the change from "generally" to "preferably" at line 15 of page 9, the change from "exposing the magnetic stripe 20" to "thereby leaving the magnetic stripe 20 normally exposed" at lines 14-15 of page 10 and the statement made by the paragraph added at the end of the original disclosure on pages 11-12.

With respect to the discussion of the prior art references, applicants were certainly unaware of 5,918,909 as of August 9, 1996, since the patent did not issue until July 6, 1999. It is queried how applicants erred in the original application by not commenting on a patent that did not issue until nearly three years after the filing of their application? With respect to the remaining discussed patents, such were brought to applicants attention during the prosecution of the applicants previous application, and were not apparently known to applicants prior to their filing date of August 9, 1996. Accordingly, discussion of all the patents now presented for discussion would comprise new matter relative to the original filing date.

With respect to the "approximately" language added to pages 7 and 8, such is new matter since applicants did not originally disclose the dimensions to be approximations.

Art Unit: 3728

With respect to the change from “generally” to “preferably”, the terms are not synonymous, as the new term indicates an advantage to the printing the original term does not.

With respect to the change from “exposing” to “normally exposed”, such is a change in degree for the exposure occurring to being a possibility.

With respect to the last paragraph, this proposal of the scope the invention was not originally expressed and to do so now would comprise new matter.

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required (The following terms employed in the claims are not so defined in the specification, rendering the structure being defined by the terms indefinite): “opaque backing”, “first panel”, “second panel”, “first panel margin”, “second panel margin”, “aperture”, “transparent layer”, and “display window”.

6. Claims 5-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 5, lines 2, 7 and 8, “said data card” lacks clear antecedent basis, as the phrase in line 1, “A data card display package for displaying a data card” indicates a “data card” as a possible adjunct, not a positive element of the claimed invention. It is indefinite whether applicants are including a data card as an element or not. This renders each subsequent reference

Art Unit: 3728

to “data card” in all of the claims as indefinite in scope. Furthermore, it is indefinite as to the meaning of the “whereby” clause of lines 7-9 as an occurrence of the claimed structure including a data card or an intended use absent the data card. There is insufficient structure defined to provide the expressed folding functionality as expressed in the “whereby” clause. Claims 11, 12 and 14 further express functionality relative to a data card which are also indefinite in view of the ambiguity of the data card and structure providing the folding. In lines 4 and 7 of claim 5, “said first panel” is indefinite, as line 3, “having first and second panels” does not distinguish one such panel. This also applies to “said second panel” in line 7.

In claim 12, lines 1-3 repeat the recitation of parent claim 11, comprising double recitation.

7. Claims 5-15 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning

Art Unit: 3728

of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

As stated in *Hester v. Stein, Inc.*, the court held that the recapture rule can be triggered by argument alone. The claims filed August 9, 1996, the arguments filed November 13, 1997 and the finally agreed-to claims in parent application Serial No. 08/694,597 are relied on to indicate the original intent of applicants. If the limitations now omitted or broadened in its description in the pending claims of the present reissue were originally presented, argued, or stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation is subject matter previously surrendered by applicant and impermissible recapture exists. In reviewing the evidence indicated in the parent application, applicant's arguments relied on the data card display pack being constructed of a one piece board with a diecut transparent window, the board folded securing a data card therebetween employing adhesive, the board including a quick release perforation feature for opening to reveal the magnetic stripe of the data card, the quick release perforation feature for opening including a bottom line of perforations intersecting the diecut transparent window, the one piece board being printed in one pass to provide data on front and back sides of the board. All of applicants' added reissue claims 5-15 provide broadening aspects to the claims that were clearly argued in the original application to overcome the rejections made in the original application. The omission or broadening in scope of the instant claims relative to a folded one piece board, the board including a diecut transparent window, a data card being included in the folded board, adhesive included to

Art Unit: 3728

secure the folded board to itself, the board including a quick release perforation feature for opening to reveal the magnetic stripe of the included data card, the one piece board being printed in one pass to provide data on front and back sides of the board are related to subject matter surrendered in the original application. Applicant is attempting to recapture claims of broader scope than that which applicant presented as being patentable in view of the original filing of claims, the response filed November 13, 1997 and the finally agreed-to allowed claims in the parent application. Applicants originally presented narrower claims and then further narrowed the claims for the purpose of obtaining allowance in the original prosecution, and applicants are now precluded from recapturing subject matter previously surrendered. The earlier prosecution constitutes an admission by applicants that the original and added limitations were necessary to overcome the prior art. The pending claims are broader than the allowed claims 1-4 in numerous aspects relevant to the prior art rejection and related to surrendered subject matter (any subject matter broader in any aspect than allowed claims 1-4 of the original application). Accordingly, impermissible recapture exists, and the pending claims other than 1-4 are rejected under 35 U.S.C. 251, based on recapture.

Applicants are required to cancel the new matter in the reply to this Office action.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit: 3728

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaiser (3,508,702). Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Schroeder (3,838,808). Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Chalmers (3,999,700). Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Sano (4,887,763). Each discloses a data card display package, comprising an opaque backing (10; 10; 10; 2 and 3; respectively) having a first panel (11; 11; 28; 2) and a second panel (13; 20; 36; 3), the panels including free edge margins, and an aperture (at 16; 29; at 38; 4) formed in the first panel, a transparent layer (at 16; 30; at 38; disclosed transparent film) bonded to the first panel and covering the aperture to define a display window, the first panel folded (as much as structurally required) over the second panel, to allow a second side of a data card so positioned to remain visible through the display window with confidential data remaining masked by the backing. Since the data card is not positively claimed (at least not definitely), the whereby clause is considered intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Art Unit: 3728

As to claim 6, each discloses the backing to be substantially rectangular in a folded condition.

10. Claims 5-6 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Fiala et al (5,918,909)(Figures 7-14). Fiala et al disclose a data card display package, comprising an opaque backing having a first panel (either 3.44 or 4.44) and a second panel (3.32 or 4.32), the panels including free edge margins, and an aperture (between bottom edge of 3.32 and 3.44 or as in Figure 13) formed in the first panel, a transparent layer (3.47 or 4.56) bonded to the first panel and covering the aperture to define a display window, the first panel folded (in Figures 9 and 10 as much as structurally required or at 4.86) over the second panel, to allow a second side of a data card so positioned to remain visible through the display window with confidential data remaining masked by the backing.

As to claim 6, the backing is substantially rectangular.

As to claim 13, disclosed is a plurality of perforations (3.50, Figure 8) disposed in panel margins for opening the package, separation of the perforations permitting the package to unfold to reveal a printed interior (see col. 8, lines 19-24).

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 3728

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Kaiser, Schroeder, Chalmers and Sano. As to claims 7 and 9-11, each discloses the aperture as a window disposed in and bordered on three sides (as well as four) by the first panel, the window disposed in a location of the first panel as claimed. To provide the aperture as by diecutting is officially noted to be a well known manner of providing such in the prior art structures, and to employ the particular claimed manner of making is not seen to unobviously define the structure of applicants' structure from any one of the prior art references. The burden is upon the applicants to come forward with evidence establishing an unobvious difference between structures. See *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983).

13. Claims 6-12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fiala et al. As to claim 6, to any degree the shape of Fiala et al is not considered substantially rectangular, the disclosed shape is sufficiently rectangular to render that particular shape a matter of design choice.

As to claims 7-12, Fiala et al discloses the aperture as a window disposed in and bordered on three sides in a peripheral edge (Figure 7) as well as four sides centrally (Figure 11) of the first panel, the window disposed in a location of the first panel as claimed. To provide the aperture as

Art Unit: 3728

by diecutting is officially noted to be a well known manner of providing such in the prior art structures, and to employ the particular claimed manner of making is not seen to unobviously define the structure of applicants' structure from any one of the prior art references. The burden is upon the applicants to come forward with evidence establishing an unobvious difference between structures. See *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). The first panel is folded onto the second panel in either embodiment of Figures 7-14.

As to claim 15, Fiala et al disclose a hanger hole (31). To provide the hanger hole as by diecutting is officially noted to be a well known manner of providing such in similar prior art structures, and to employ the particular claimed manner of making is not seen to unobviously define the structure of applicants' structure from any one of the prior art references. The burden is upon the applicants to come forward with evidence establishing an unobvious difference between structures. See *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983).

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Goade Sr discloses a data card package including an opaque backing, a transparent layer and a data card. Smith et al disclose a data card package including an opaque backing, an aperture and a data card.

15. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to

Art Unit: 3728

the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners, M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

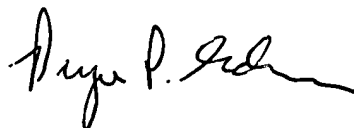
If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Ebony Smith at (703)305-3570.

For applicant's convenience, the Group Technological Center FAX number is (703) 305-3579 or (703)305-3580. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Gehman of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Bryon Gehman whose telephone number is (703) 308-3866.

BPG

September 10, 2000



Bryon P. Gehman
Primary Examiner